

Application No. 10/649,459
Response to 1 February 2006 Non-Final Office Action

REMARKS

Claims 1-15 are pending. By this Amendment, claims 1-2, 4, 8, and 12 are amended.

In view of the foregoing amendments to the claims, reconsideration and withdrawal of the rejection are respectfully requested.

Claim Objections

In the Office Action, claim 6 is objected to for insufficient antecedent basis for reciting "the individual identification device." The amendment to claim 6 revises claim 4 to depend from claim 2, where the term "individual identification device" is first introduced. As claim 6 depends from claim 5, which in turn depends from claim 4. Claim 4 is amended to depend from claim 2. Therefore, Applicants submit that the term "individual identification device" now has proper antecedent basis.

35 U.S.C. § 103

Claims 1, 4, 5, and 7 are rejected under 35 U.S.C. § 103(a) as obvious over Walter (U.S. 6,275,141). Applicants respectfully traverse this rejection and request reconsideration and withdrawal of the rejection. In pertinent part, claim 1 recites:

a restriction information generation device connected to the first verification device, wherein when the input identification information matches the pre-registered identification information, operation restriction information for

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designating an operation of the vehicle and the accessory that is to be restricted is
registerable by a user in the restriction information generation device

There is no teaching or suggestion in Walter that meets the above recitation. Specifically, Walter does not suggest or teach registrability "of an operation of the vehicle and the accessory that is to be restricted" upon inputting identification information matching pre-registered identification information.

To the contrary, Walter teaches an arrangement only for switching between modes, e.g., a normal mode and a valet mode, in which the operations of the vehicle and accessories that are to be restricted have been designated ahead of time. More particularly, the user does not have any choice as to which operations and accessories are to be restricted contrary to the claimed invention.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, as stated in MPEP 2145, "[a] prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness."

In rejecting claims under 35 USC 103, the Examiner is required to establish a factual basis in support of the legal conclusion of obviousness. See In Re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In this case, a factual basis has not been established. There has been no citation to any portion of Walter that teaches or suggests the recitations in claim 1 directed to registrability "of an operation of the vehicle and the accessory that is to be

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restricted” upon inputting identification information matching pre-registered identification information.

In addition to making factual determinations as set forth in Graham v. John Deere Co., 383 US 1, 17, 148 USPQ 467 (1966), the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to meet the recitations of the claimed invention based on other than hindsight. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). Specifically, the teaching or suggestion to make the asserted modification must be found in the prior art, and not based on applicant’s disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present Office Action on Page 3 acknowledges that Walter does not disclose “a separate restriction information generation device” but nonetheless asserts that:

[O]ne of the ordinary skill in the art at the time of the invention could realize the internal operation of the processing unit of Walter in a separate device in order to reduce the complexity and cost of the processing unit.

However, there is no citation to *prior art* where this teaching or suggestion for the above modification may be found. While the complexity of the processing unit may be reduced by providing a separate device as asserted in the Office Action, this nevertheless results in an *overall increase* in the complexity of the disclosed arrangement because there is no an additional separate device. There is no motivation or suggestion in the prior art for increasing the complexity of the overall arrangement other than hindsight based on the claimed invention and thus the rejection is improper.

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Claim 1 further recites:

an user operable input device arranged in one of the electronic key and the vehicle
to input identification information.

There is no teaching or suggestion in Walter that meets the above recitation. The
input device (receiver) 114 of Walter is not operated by a user to input identification
information. Walter merely discloses the input device (receiver) 114 receiving radio
signals. See Walter column 7, lines 31-34.

Accordingly, applicants respectfully request reconsideration and withdrawal of
the rejection of claim 1 as obvious over Walter. Likewise, the same is requested for the
obviousness rejections of claims 2-7 as these claims all depend directly or indirectly from
claim 1.

Regarding the remaining independent claims, i.e. claims 8 and 12, the Office
Action rejects both of these claims as obvious over Walter in view of US Patent No.
6,980,086 to Papp. For the same reasons as discussed above in connection with claim 1,
reconsideration and withdrawal of the rejection of claims 8 and 12 is also requested.

In this regard, the Office Action applies Walter to claims 8 and 12 in the same
way as claim 1, and thus the rejections are improper for the same reasons as discussed for
claim 1. The withdrawal of rejections to claims 9-11 and 13-15 is additionally requested
as these claims all depend directly or indirectly from one of claims 8 or 12.


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CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance.
Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


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